

**REMARKS**

In the Office Action mailed December 17, 2009, the Examiner rejected claims 1-17, 20, and 22 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,270,000 to Goldner et al. (Goldner) and an article titled "Paper Shredding Business Piles Up," by Nealy-Brown; rejected claim 18 under 35 U.S.C. § 103(a) as unpatentable over U.S. Goldner, Nealy-Brown, and U.S. Patent No. 5,209,411 to Dineley et al. (Dineley); rejected claim 19 under 35 U.S.C. § 103(a) as unpatentable over Goldner, Nealy-Brown, and U.S. Patent No. 6,494,391 to Mosenson et al. (Mosenson); and rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over Goldner, Nealy-Brown, and U.S. Patent No. 5,186,397 to Orlando.

By this amendment, Applicants amend claims 1 and 19 to more clearly define the features of those claims.

Claims 1-22 are currently pending.

The Examiner rejected claims 1-17, 20, and 22 under 35 U.S.C. § 103(a) as unpatentable over Goldner and Nealy-Brown. Applicants respectfully traverse this rejection.

Claim 1, as amended, defines a method of destroying documents. The method includes, among other things, "supplying the documents including protected health information to an apparatus adapted to shred documents and medical waste, the apparatus having little or no liquid effluent and little or no toxic air emissions." The Examiner acknowledges that Goldner fails to disclose documents including protected health information (e.g., the types of documents and information requiring protection under HIPAA). To cure that gap, the Examiner relies on Nealy-Brown.

However, although Nealy-Brown discloses that medical records can be shredded,

nowhere does Nealy-Brown suggest or disclose that documents including protected health information can be shredded with medical waste, much less a mechanism having little or no liquid effluent and little or no toxic air emissions. Indeed, Nealy-Brown *teaches away* from claim 1 by suggesting the use of traditional document shredding (see, e.g., Nealy-Brown, page 2 of 2, second paragraph) that merely shreds paper without processing the medical waste (e.g., processing by using heat, ozone, etc.) to yield little or no liquid effluent and little or no toxic air emissions.

In view of the foregoing, neither Goldner nor Nealy-Brown suggests or discloses at least the following feature of claim 1: "supplying the documents including protected health information to an apparatus adapted to shred documents and medical waste, the apparatus having little or no liquid effluent and little or no toxic air emissions." Therefore, claim 1 and claims 2-17, 20, and 22, at least by reason of their dependency from independent claim 1, are allowable over Goldner and Nealy-Brown, whether those references are taken alone or in combination, and the rejection of those claims under 35 U.S.C. § 103(a) should be withdrawn.

Regarding the motivation to combine, Applicants submit that one of ordinary skill in the art would not be motivated to make the Goldner-Nealy-Brown combination proposed by the Examiner. Applicants submit that Nealy-Brown *teaches away* from claim 1, as noted above.<sup>1</sup> As such, one of ordinary skill in the art would not be motivated to make the combination proposed by the Examiner. Therefore, the rejection of claims 1-17, 20, and 22 under 35 U.S.C. § 103(a) as unpatentable over Goldner and Nealy-Brown should be

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<sup>1</sup> MPEP §2141.02 further notes that "a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

withdrawn for this additional reason.

The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as unpatentable over Goldner, Nealy-Brown, and Dineley. Applicants respectfully traverse this rejection.

Claim 18 depends from claim 1 and includes all of the features recited therein including, among other things, "supplying the documents including protected health information to an apparatus adapted to shred documents and medical waste, the apparatus having little or no liquid effluent and little or no toxic air emissions." For at least the reasons noted above with respect to claim 1, neither Goldner nor Nealy-Brown discloses or suggests this feature. Moreover, although Dineley describes decontamination of medical waste, it fails to cure this noted deficiency. Nor does the Examiner alleges that Dineley cures this noted deficiency. Therefore, claim 18 is allowable over Goldner, Nealy-Brown, and Dineley, whether those references are taken alone or in combination, and the rejection of claim 18 under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected claims 19 under 35 U.S.C. § 103(a) as unpatentable over Goldner, Nealy-Brown, and Mosenson. Applicants respectfully traverse this rejection.

Claim 19 depends from claim 1 and includes all of the features recited therein including, among other things, "supplying the documents including protected health information to an apparatus adapted to shred documents and medical waste, the apparatus having little or no liquid effluent and little or no toxic air emissions." For at least the reasons noted above with respect to claim 1, neither Goldner nor Nealy-Brown discloses or suggests this feature. Moreover, although Mosenson discloses treating medical waste, Mosenson fails to cure this noted deficiency. Nor does the Examiner alleges that Mosenson cures this noted deficiency. Moreover, Applicants submit that Mosenson uses a cavity (see ozone generator 70) rather than an ozone electrode inserted

into the chamber, as recited in claim 19. In view of the foregoing, claim 19 is allowable over Goldner, Nealy-Brown, and Mosenson, whether those references are taken alone or in combination, and the rejection of claim 19 under 35 U.S.C. § 103(a) should be withdrawn.

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over Goldner, Nealy-Brown, and Orlando. Applicants respectfully traverse this rejection.

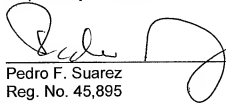
Claim 21 depends from claim 1 and includes all of the features recited therein including, among other things, "supplying the documents including protected health information to an apparatus adapted to shred documents and medical waste, the apparatus having little or no liquid effluent and little or no toxic air emissions." For at least the reasons noted above with respect to claim 1, neither Goldner nor Nealy-Brown discloses or suggests this feature. Moreover, although Orlando discloses disposing medical waste, Orlando fails to cure this noted deficiency. Nor does the Examiner alleges that Orlando cures this noted deficiency. In view of the foregoing, claim 21 is allowable over Goldner, Nealy-Brown, and Orlando, whether those references are taken alone or in combination, and the rejection of claim 21 under 35 U.S.C. § 103(a) should be withdrawn.

**CONCLUSION**

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant is concurrently filing herewith a Petition for a three-month extension of time with the requisite fee. Authorization for a credit-card payment of the filing fees mentioned above is submitted herewith. No additional fees are believed to be due, however the Commissioner is authorized to charge any additional fees or credit overpayments to Deposit Account No. 50-0311, reference No. 36707-501. If there are any questions regarding this reply, the Examiner is encouraged to contact the undersigned at the telephone number provided below.

Respectfully submitted,

  
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Date: 19 May 2009\_\_\_\_\_

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